

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/529,343	Applicant(s) BROWNELL, JAMES HAYDEN
Examiner PATRICK STAFFORD	Art Unit 2828

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 May 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Amendment is non-compliant. See attached Notice. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s) _____.
13. ☐ Other: _____.

/AMIR ZARABIAN/
Supervisory Patent Examiner, Art Unit 2827

Continuation of 11, does NOT place the application in condition for allowance because: in response to applicant's argument that the restriction requirement be transversed, the restriction requirement was between the grating horn of claims 2-10 and the system of claims 11-18. The two groups do not relate to a single general inventive concept because the grating horn element of claims 2-10 comprises technical features which are not required in the system of claims 11-18, such as the system lacking the V-groove and vertex to the flat base and the generation of terahertz radiation, as required by claims 2-10. In response to applicant's arguments, the recitation grating horn of claim 2 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In response to applicant's argument that the limitations of claim 2 act as a grating horn, the examiner has interpreted claim 2 to define a grating horn based on the limitations present in the claim. Each limitation was addressed and taught by the prior art applied (Kramer '956 and Walsh '043). The fact that the limitations of the claim were addressed and taught by the references demonstrates that the references teach the grating horn as defined by the structural limitations presented and claimed in claim 2. In response to applicant's argument that Kramer '956 does not teach the grating elements being inherently oriented in phase, Kramer '956 was not relied upon to teach the inherency of the grating elements being oriented in phase. Instead, Kramer '956 is relied upon to teach a pair of grating elements (Fig. 5, parts 50 and 52), which are adjustable (col. 11, lines 50-61). The phase orientation of these elements is adjustable and so it would have been obvious to one having ordinary skill in the art at the time the invention was made to orient the adjustable phase orientations of the gratings in Kramer '956 to be in phase. In response to applicant's argument that '043 does not teach both a rectangular and a triangular component and a ruling in the rectangular and triangular component, the claim states "wherein each of the grating elements is ruled in the triangular and rectangular components and parallel to the flat base." The claim does not require the rulings to be inside the rectangular and triangular components, but instead requires triangular and rectangular components and the grating element is ruled. This is taught by '043, which teaches both triangular (col. 8, lines 30-35) and rectangular components (col. 8, lines 10-16) and rulings in the grating element (col. 11, lines 7-11 and Fig. 9A, part 16). The interpretation of the word "in" in claim 10 does not require the limitation of "inside" each component. As claimed, claim 10 can read that the grating element is ruled in triangular and rectangular components, or that the triangular and rectangular elements are the rulings in the grating element. The limitations of claim 10 and more specifically the limitations regarding the rectangular and triangular components do not require anything more than there be components and the grating element is ruled. The current limitations of claim 10 invited this interpretation, which is read on by Kramer '956 and Walsh '043. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, '956, '043 and '075 were combined in the rejection of claim 6. The motivation to combine was for the purpose of producing a more sharp moire pattern, which is taught by '075 in column 6, lines 35-39, as cited in the previous office action on page 4. In response to applicant's argument that the combination of '956, '043 and '075 would not yield a workable device, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In response to applicant's argument that Hamada '075 does not teach the sharp moire pattern resulting when combined with Kamada '956 and Walsh '043, it is not required that the references clearly anticipate each other and explicitly teach curing the deficiencies of the other, rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The combination of '956, '043 and '075 results in the claimed device of claim 6.